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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,700	01/28/2004	Buell Andrew Pratt	092807.011500	8931
33717 7590 06/23/2009 GREENBERG TRAUIG LLP (L.A.) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404				
EXAMINER				
LEE, JOHN W				
ART UNIT		PAPER NUMBER		
2624				
MAIL DATE		DELIVERY MODE		
06/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,700

Applicant(s)

PRATT ET AL.

Examiner

JOHN Wahnkyo LEE

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- The application was forwarded to the examiner on 14 April 2009.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 27-37 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claims 27-37, while defining an archive, does not define a "computer-readable medium" and is thus non-statutory for that reasons. An archive can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure

and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 27-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Reimer et al. (US 5,553,221).

Regarding claim 27, Reimer discloses an archive of a plurality of media segments from a motion picture comprising: a roll formed by winding (Fig. 7-702, col. 12, line 14, "the negative film"; col. 12, line 51, "VCR") plurality of media segments (Fig. 7-704; col. 12, line 31, "frame"), each segment spliced to another of the segments (Fig. 7-724; col. 12, line 30), wherein each segment has a location within said roll and a first information (Fig. 1-108; col. 13, line 36, "foundation information related to each frame can be identified, located and retrieved "); and a database (Fig. 1-112; col. 13, lines 37-38, foundation information database") having a record for each segment associating the location of the segment within said roll, with said first information (col. 13, lines 35-38); whereby said database provides said first information and the associated location in said roll of the plurality of media segments (col. 13, lines 35-38); and whereby the physical volume required to store said plurality of media segments is reduced (col. 23, lines 25-34, "create a personalized version of movie") and the accessibility of said

plurality of media segments is maintained (col. 23, lines "may include not in the theatrical presentation or the VCR video version ...").

Regarding claim 28, Reimer discloses that the first information is comprised of at least one of a key number associated with a first end of the segment, a splice designation, and a note labeling the segment (col. 13, line 44, "end time code").

Regarding claim 29, Reimer discloses that wherein one of the segments has a frame, said frame having a second information and a location in said roll (col. 16, line 19, "index information"); said database further having a record associating the location of said frame with said second information; whereby said database provides said second information and the location in said roll associated with the frame (col. 16, lines 16-23).

Regarding claim 30, Reimer discloses that the consolidated archive of claim 29, wherein said second information comprises at least one of a key number, a slate record, a flash frame designation, and a wave designation (col. 16, line 19, "index information").

Regarding claim 31, Reimer discloses further comprising: a digitized media file of said plurality of file segments said media file having a substantial correspondence to said roll (Fig. 7-704; col. 12, line 31, "frame"); whereby said database, from the location in said roll of said frame, identifies a portion of said media file substantially representative of said frame (col. 13, lines 35-38).

Regarding claim 32, Reimer discloses further comprising: a digitized media file of said plurality of file segments (Fig. 7-704; col. 12, line 31, "frame"), said media file having a substantial correspondence to said roll (col. 13, lines 35-38); whereby said

database, from the location in said roll of said frame, identifies a portion of said media file substantially representative of said frame (col. 13, lines 35-38).

Regarding claim 33, Reber discloses that wherein one of the segments has a frame (Fig. 7-704; col. 12, line 31, "frame"), said frame having a second information (col. 16, line 19, "index information") and a location in said roll (col. 13, lines 35-38); said database further having a record associating the location of said frame with said second information (col. 13, lines 35-38); whereby said database provides said second information and the location in said roll associated with the frame (col. 13, lines 35-38); and whereby said database, from the location in said roll of said frame, identifies a portion of said media-file substantially representative of said frame (col. 13, lines 35-38).

Regarding claim 34, Reber discloses further comprising: a client (Fig. 1-106; col. 6, line 43, "user device") a media server having access to said media file (col. 6, lines 49-50, "distributing computing environment"); and a network (Fig. 1-124, col. 6, lines 45-46, "communication medium"); said network connecting said client to both said database and said media server; thereby providing said client with communication to both said database and said media server (col. 6, lines 43-56); at least one of said database and said client further having a means for selecting from the media server a portion of the media file to be provided to the client (col. 6, lines 57-67); said client comprising a means for searching the database (col. 6, lines 57-67); a means for displaying results provided by the database (col. 6, lines 57-67); and a means for displaying the portion of the media file provided by the media server (col. 6, lines 57-

67); whereby the accessibility of said plurality of media segments is increased (col. 6, lines 57-67).

Regarding claim 35, Reimer discloses that said media file is streaming media (col. 6, lines 49-50, "distributing computing environment").

Regarding claim 36, Reimer discloses that wherein said media file is suitable for use by a non-linear editing station (Fig. 1-106; col. 6, line 43, "user device").

Regarding claim 37, Reimer discloses wherein the client further comprises: a first means for indicating to said database a portion of said roll and a format for delivery (col. 7, lines 7-20); said database responsive to said first means, such that an order is generated to prepare said portion of said roll according to the format; whereby a user of the client can order the media segments from the consolidated archive (col. 7, lines 7-20).

. Regarding claim 38, claim 38 is analogous and corresponds to claim 27. See rejection of claim 27 for further explanation.

Conclusion

4. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN Wahnkyo LEE whose telephone number is (571)272-9554. The examiner can normally be reached on Monday - Friday (Alt.) 7:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on (571) 272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHARLES KIM/
Primary Examiner, Art Unit 2624

/John Wahnkyo Lee/
Examiner, Art Unit 2624